



Ex parte Horton

Patent and Trademark Office Board of Patent
Appeals and Interferences

Opinion dated Apr. 26, 1985

United States Patents Quarterly Headnotes

PATENTS

[1] Reissue -- In general (§ 58.1)

Restriction imposed by 35 USC 303 and its implementing regulations, under which patent claims are reexamined on basis of "patents or printed publications," does not apply only to new prior art cited in request for reexamination.

PATENTS

Particular Patents -- Bracket Assembly

Re. 28,176, Horton, Bracket for Mounting Boat Accessory, Claims 1, 2, 4, 5, 8, 9, 31/1, 31/2, 31/4, 31/5, 31/8, and 31/9, rejected.

*698 Appeal from Art Unit 355.

Reexamination No. 90/000034, filed July 27, 1981 and No. 90/000202, filed May 21, 1982, of Re. Patent No. 28,176, issued Oct. 1, 1974, based on application, Serial No. 401,812, filed Sept. 28, 1973, which is reissue of No. 3,674,228, issued July 4, 1972.

Arthur F. Zabal, for appellant.

Before Serota, Henon, Craig, Keenan, and McCandlish, Examiners-in-Chief.

Keenan, Examiner-in-Chief.

This appeal is from the decision of the examiner finally rejecting claims 1 through 50 in reexamination proceeding Control Nos. 90/000034, and 90/000202. [FN1] Claims 1 through 11 are all of the claims of

United States Patent No. Re 28,176, reissued October 1, 1974. Claims 12 through 50 have been added by the patentee (appellant) in these proceedings. We reverse and add new grounds of rejection pursuant to 37 CFR 1.196(b).

The invention relates to a bracket assembly for mounting an auxiliary electric trolling motor on a boat. The bracket assembly is designed to permit movement of the motor from an extended vertical position wherein the propeller is submerged in the water to a retracted position wherein the motor is supported horizontally on the forward deck portion of the boat. Claim 1 is illustrative of the subject matter on appeal. It reads as follows:

1. Apparatus for mounting a motor to a boat for movement between an extended position and a retracted position, said motor being of the type having propeller means coupled to one end of an elongated member, said apparatus comprising:

mounting means including base means adapted to be secured to the deck of a boat,

first and second arm means having first ends pivotally connected to said mounting means at spaced positions for pivotal movement about first and second spaced pivot axes respectively above said base means to allow movement of the other ends of said arm means between extended and retracted positions,

said first pivot axis to be located inward of said second pivot axis when said mounting (sic) means is secured in place,

said first pivot axis being located at a distance above said base means which is at least the same distance between said second pivot axis and said base means,

said second arm means having a length less than the length of said first arm means, and

support means for holding the other end of said elongated member,

said support means being pivotally coupled to the other ends of said first and second arm means at spaced pivot positions for pivotal movement about third and fourth spaced pivot axes respectively to support [a] the motor in an operating position with its propeller in the water when said first and second arm means are in their

extended position and to support [a] the motor out of the water when said first and second arm means are in their retracted positions,

said third pivot axis being formed between said support means and the other end of said first arm means,

said fourth pivot axis being formed between said support means and the other end of said second arm means,

the distance between said first and third pivot axes being greater than the distance between said second and fourth pivot axes and the distance between said third and fourth pivot axes being greater than the distance between said first and second pivot axes.

References relied upon by the examiner in this appeal are:

Harvey 1,824,887 Sep. 29, 1931

Harvey 1,840,948 Jan. 12, 1932

Harvey 1,840,949 Jan. 12, 1932

Three photographs submitted by appellant during the prosecution of Reissue Application No. 401,812, filed Sep. 28, 1973, hereinafter referred to as the "Dale Bracket."

BACKGROUND

A brief discussion of events surrounding this appeal is in order and will prove helpful in understanding the issues before us.

Appellant's original U.S. Patent No. 3,674,228 issued July 4, 1972. Appellant filed reissue application Serial No. 401,812 on September 28, 1973 amending original patent claims 1 through 7 to more narrowly define his invention and adding new, also narrower, claims 8 through 11. Appellant *699 filed the reissue application in light of new information relating to public use of a similar device more than one year prior to the filing date of his original patent application. Photographs, purported to be of the device in public use, were attached to the reissue oath. These photographs are referred to, collectively, as the "Dale bracket." The examiner allowed all of the claims in the reissue application in the first Office action.

Anderson-Needham Sales Co. (requestor) has requested reexamination of appellant's Patent No. Re. 28,176. [FN2] Requestor is defendant in a related civil action filed in the District Court for the Northern District of Texas, styled George F. Horton, Plaintiff, v. Anderson-Needham Sales Co., Defendant, Civil Action No. 4-79-310K.

In these reexamination proceedings, requestor urged

that claims 1 through 6 and 8 of appellant's reissue patent are anticipated (35 USC § 102) by any of the Harvey patents, and that claim 7 is unpatentable (35 USC § 103) over any of the Harvey patents in view of the Dale bracket. The decisions to grant reexamination in both proceedings appear to have been based primarily on the grounds advanced by the requestor. The examiner, however, has rejected the claims on different grounds, as stated below.

THE REJECTIONS

Claims 3, 14, 15, 17, 21, 22, 24, 29, 30, 34 through 44 and 47 through 50 stand rejected under 35 USC § 112, first paragraph, as lacking sufficient basis in the reissue patent. The examiner has set forth no fewer than eight separate grounds of rejection relating to various groupings of these claims. We refer to pages 42 through 45 of the answer for the complete statement thereof. The thrust of the examiner's position is that the angular and positional relationships between bracket elements as recited in these claims are not sufficiently disclosed in the reissue patent. The examiner acknowledges that the drawings seem to support the recitations at issue but asserts that, since patent drawings are not drawn to scale, they cannot be relied upon to supplement or remedy deficiencies in the written portion of the disclosure.

Claims 1 through 50 stand rejected under 35 USC § 103 as being unpatentable over the Dale Bracket in view of any of the Harvey patents ('887, '948, or '949). The rejection is explained in detail on pages 46 through 48 of the answer.

OPINION

The 35 USC § 112 Rejection

We note at the outset that the examiner has included original, unamended reissue patent claim 3 in this rejection under 35 USC § 112. Such rejection is clearly outside the scope of reexamination. According to 37 CFR 1.552(b), only new or amended claims presented during a reexamination proceeding are examined for compliance with the requirements of 35 USC § 112 (as well as the new matter prohibition of 35 USC § 132). On this basis alone, we cannot sustain the section 112 rejection of claim 3.

With respect to the remaining lack of disclosure rejections which are applied against claims added by appellant during these proceedings, it is well settled that drawings may be relied upon to satisfy the disclosure requirements of 35 USC § 112. See *In re Berkman*, 642 F.2d 427, 209 USPQ 45 (CCPA 1981), citing *Breen v. Cobb*, 487 F.2d 558, 179 USPQ 733 (CCPA 1973); *In re Reynolds*, 58 CCPA 1287, 443 F.2d 384, 170 USPQ 94 (1971); *In re Wolfensperger*, 49 CCPA 1075, 302 F.2d 950, 133 USPQ 537 (1962).

In support of his own position, the examiner relies upon *In re Olson*, 41 CCPA 871, 212 F.2d 590, 101 USPQ 401 (1954) cited and distinguished in *In re Wolfensperger*, supra. In particular, the examiner relies upon the statement by the Court in *Olson* that:

Ordinarily drawings which accompany an application for a patent are merely illustrative of the principles embodied in the alleged invention claimed therein and do not define the precise proportions of elements relied upon to endow the claims with patentability.

The examiner has, however, overlooked the construction placed on *Olson* by the Court in *Wolfensperger*. In the latter case, the Court stated with regard to *Olson*:

We have carefully considered that opinion and it is our view that it stands only for the proposition that if drawings which are relied on for supporting disclosure do not in fact contain it, then disclosure is lacking (emphasis in original).

The claim limitations at issue in *Olson* described spatial relationships on the order of a few

thousandths of an inch which simply could not be ascertained from the drawings. This is a far cry from the case at hand where mere inspection of the drawings reveals each and every angular and positional relationship *700 upon which the examiner's rejections are based. Moreover, even though appellant's patent drawings may not be drawn to scale, one of ordinary skill in the art would suspect that there was some reason for the positional relationships between components clearly illustrated therein. In other words, the illustrated relationships would not, in our opinion, be dismissed as accidental or arbitrary.

For the foregoing reasons, we will not sustain any of the rejections based on 35 USC § 112 for lack of sufficient disclosure.

The 35 USC § 103 Rejection

The rejection of claims 1 through 50 as being unpatentable over the Dale bracket in view of any of the Harvey patents cannot be sustained for several reasons.

First, there is nothing in the record of these proceedings, nor in the record of the prosecution of appellant's reissue patent, which establishes the Dale bracket photographs themselves as "prior art" under 35 USC § 102. The undated and apparently unpublished photographs were not brought to appellant's attention until February, 1973, well after the filing date of his original patent application. The precise origin of the photographs, where they were taken, when they were taken, and the origin of the device disclosed therein, is unclear. For example, the Horton affidavit of record (Exhibit C of appellant's brief) provides only scant information as to the origin of the photographs themselves. On page 3 thereof the affiant states:

In February of 1973, I had a meeting with Mr. Schaeperklaus, patent counsel for the Herschede Hall Clock Company and at the meeting, Mr. Schaeperklaus provided three negatives of a Dale Bracket. According to Mr. Schaeperklaus, he had conducted an investigation with respect to the Dale Bracket. Subsequently, prints were made from the three negatives and submitted in the reissue application serial no. 401,812.

As to the substantive content of the photographs, appellant acknowledges in his reissue application oath only that the bracket disclosed in the

photographs, or a bracket similar to that shown in the photographs, had been in public use in this country more than one year prior to the date on which original application 054,819 was filed.

The examiner has taken the position that the photographs per se were submitted by appellant as prior art; however appellant has consistently challenged the examiner's characterization in this regard, and it remains that there is nothing in the record upon which we can base a conclusion that the Dale bracket photographs themselves constitute prior art which can be applied against the appealed claims.

Moreover, even assuming, arguendo, the photographs were submitted by appellant as prior art with respect to the claims before us, we agree with appellant that the examiner's reliance thereon is improper in these limited proceedings.

The examiner contends that the delineation of the scope of reexamination in 37 CFR 1.552, and, specifically, the limitation to consideration of patents and printed publications, applies only to new art submitted at the time of the request for reexamination.

In our opinion, the examiner has clearly erred in his interpretation of the statute and implementing rules relating to reexamination.

Section 302 of Title 35 of the United States Code states in part that:

Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

Section 301 provides in part:

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent (emphasis ours).

Reexamination proceedings in the PTO are instituted upon a determination that there is a substantial new question of patentability pursuant to 35 USC § 303 which reads:

§ 303. Determination of issue by Commissioner

(a) Within three months following the filing of a

request for reexamination under the provisions of section 302 of this title, the Commissioner will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Commissioner may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title (emphasis ours).

Once a determination of a substantial new question of patentability has been made, reexamination commences. The scope of reexamination is clearly defined in 37 CFR 1.552(a) and (b) which provide:

(a) Patent claims will be reexamined on the basis of patents or printed publications.

(b) Amended or new claims presented during a reexamination proceeding must not enlarge the scope of the claims of the patent and will be examined on the basis of patents *701 or printed publications and also for compliance with the requirements of 35 U.S.C. § 112 and the new matter prohibition of 35 U.S.C. § 132 (emphasis ours).

Note that the examiner is not limited to a consideration of just those patents and/or printed publications cited by the requestor, or even to those upon which the substantial new question of patentability was made.

Section 2256 of the MPEP provides further clarification and guidance as to the sources of prior art which the examiner can consider in reexamination. It specifies that

The primary source of prior art will be the patents and printed publications cited in the request.

The examiner must also consider patents and printed publications

-- cited by a reexamination requester under § 1.510

-- cited in patent owners' statement under § 1.530 or a requester's reply under § 1.535 if they comply with § 1.98

-- cited by patent owner under a duty of disclosure (§ 1.555) in compliance with § 1.98

-- discovered by the examiner in searching

-- of record in the patent file from earlier examination

-- of record in patent file from § 1.501 submission prior to date of an order if it complies with § 1.98

The reexamination file must indicate which prior art patents and printed publications the examiner has considered during ex parte examination (emphasis ours).

Other issues, aside from those outlined above, are excluded from reexamination proceedings. Thus, 37 CFR 1.552(c) provides

Questions other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such questions are discovered during a reexamination proceeding, the existence of such questions will be noted by the examiner in an Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such questions considered and resolved.

Section 2258 of the MPEP provides further support for our position. It states in part:

Rejections on prior art in reexamination proceedings may only be made on the basis of prior patents or printed publications.

Rejections will not be based on matters other than patents or printed publications, such as public use or sale, inventorship, § 101, fraud, etc.

If questions other than those indicated above (for example, questions of patentability based on the public use or sale, fraud, abandonment under 35 U.S.C. § 102(c), etc.) are discovered during a reexamination proceeding, the existence of such questions will be noted by the examiner in an Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such questions considered and resolved (emphasis ours).

[1] As is readily apparent, there is nothing in the

statute or implementing regulations which supports the examiner's contention that the "patents and printed publications" restriction in the statute and rules applies only to new prior art cited in the request for reexamination. The statutory provisions, implementing rules, and reexamination procedures set out in the MPEP are clearly contra. The legislative history of reexamination is also in direct opposition to the examiner's view. Commissioner Diamond, in hearings before the Committee on the Judiciary, United States Senate, Ninety-Sixth Congress, First Session, on S. 1679, stated:

By limiting reexamination to a consideration of prior patents and printed publications, the PTO would be given a task that it can perform effectively at reasonable cost. [FN3]

In a similar vein, when the implementing rules were published, Acting Commissioner of Patents and Trademarks Tegtmeyer stated:

The scope of the reexamination proceeding which was originally proposed has been essentially adopted in the final rules. The suggestions that the rules be broadened to include other issues have not been adopted since the other issues would unduly complicate the proceedings, raise the expense of the proceedings and raise questions whether such issues can be considered under Pub. L. 96-517. 1050 TMOG 87

With specific regard to 37 CFR 1.552, the Acting Commissioner stated:

Insofar as the actual reexamination is concerned, the examination as to original patent claims is only on the basis of patents or printed publications . . . New § 1.552 also *702 provides that questions relating to matters other than those identified in paragraphs (a) and (b) of the section would merely be noted by the examiner as being an open question in the record. Patent owners could then file a reissue application if they wish such questions to be resolved.

The rules have been written to follow the statute which speaks only to reexamination based on patents and printed publications. 1050 TMOG 90

While there is no case law directly on point, we nevertheless direct attention to In re Etter, 756852756

F.2d 852-----, 225 USPQ 1 (Fed. Cir. 1985)
wherein Judge Markey, writing for the majority,
states:

Patent claims are reexamined only in light of
patents or printed publications under 35 U.S.C. §
102, 103, and only new or amended claims are
also examined under 35 U.S.C. § § 112 and 132.
37 CFR 1.552; MPEP § 2258.

In the accompanying footnote, Judge Markey
explains in part:

If a patent owner requests reexamination, but
desires consideration of wider issues, e.g., prior
public use or sale, he must obtain such
consideration by filing a reissue application. 37
CFR 1.552; MPEP § § 2212, 2258.

While the Court's remarks on this issue may be
dicta, nevertheless, we view them as reflective of the
Court's own interpretation of the scope of
reexamination, and as supportive of the Board's
position stated herein.

Finally, we note that the examiner, in contending
that the Dale bracket photographs were submitted by
appellant during the prosecution of Reissue
Application 401,812 as prior art, apparently
considered appellant's action as an admission of prior
art. [FN4] 37 CFR 1.550(a) indicates that
reexamination will be conducted in accordance with
§ 1.104-1.119. Among these rules is § 1.106(c)
which provides:

(c) In rejecting claims the examiner may rely
upon admissions by the applicant, or the patent
owner in a reexamination proceeding, as to any
matter affecting patentability and, insofar as
rejections in applications are concerned, may
also rely upon facts within his or her knowledge
pursuant to § 1.107. [FN5]

While the examiner did not cite this rule in support
of his position, we raise the point here because it
appears to open reexamination proceedings to any
and all issues affecting patentability so long as there
is a related admission. However, we are compelled
to construe the rule in light of the statute and other
implementing rules which, as we discussed
hereinabove, specifically restrict reexamination to a
consideration of patents and printed publications.
[FN6] Thus, for an admission to form some or all of
the basis for a prior art rejection in reexamination
proceedings, such admission must necessarily relate

to patents or printed publications. Otherwise,
patentees or patent owners would be able to
circumvent the restrictive nature of the statute by
making admissions relating to prior public use, sale,
abandonment, etc., issues which, as we have seen,
were never intended to be resolved by way of
reexamination. Here, if appellant has admitted
anything in submitting the Dale bracket photographs
during the prosecution of his reissue application, it is
that there may have been a public use of a device of
the type disclosed in the photographs. We agree with
appellant that resolution of this issue is outside the
scope of reexamination proceedings.

For the reasons stated hereinabove, we will not
sustain the section 103 rejection of claims 1 through
50.

Under the provisions of 37 CFR 1.196(b), the
following rejections are entered by the Board.

Claims 1, 4, 8, 9, and 31/1, 31/4, 31/8 and 31/9 are
rejected under 35 USC § 102 as anticipated by
Harvey ('948).

Each of the limitations recited in these claims is met
by the reference. We note particularly that the
interior surface of the bottom 9 of Harvey's boat may
be broadly construed as a "deck." In any event, the
phrase in claim 1 calling for "base means adapted to
be secured to the deck of a boat" requires no structure
other than that which is already found in the
reference.

In addition, the first and second arms 18, 16,
respectively, of Harvey ('948) provide at least some
degree of support for the motor in both the extended
and retracted positions. In this regard, the claims do
not specify that the arms provide the sole support for
the motor.

That the remaining limitations in the rejected claims
are met by Harvey ('948) is self evident and requires
no further discussion.

*703 Claims 2, 5, 31/2 and 31/5 are rejected under
35 USC § 103 as being unpatentable over Harvey
('948). The type of motor supported by the support
means is regarded as a matter well within the ambit
of the ordinarily skilled worker in the art.

Any request for reconsideration or modification of
this decision by the Board of Patent Appeals and
Interferences based upon the same record must be
filed within thirty days from the date of the

decision(37 CFR 1.197). Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire thirty days from the date of the decision.

FN1 The proceedings were merged on June 10, 1983 pursuant to 37 CFR 1.565(c). See Paper No. 25 in the '034 proceeding and Paper No. 9 in the ' 202 proceeding. In accordance with the merger decision, the claims as well as subsequent actions and responses in each file were made identical. Our decision here applies jointly to both proceedings.

FN2 Anderson-Needham is the named requestor in both of the proceedings.

FN3 See p. 15 of Exhibit E attached to appellant's reply brief.

FN4 As we noted earlier, appellant takes issue with this specific point on page 50 of the brief and pages 1 and 2 of the reply brief.

FN5 Similar language is found in § 2258 of the MPEP.

FN6 As we noted early on this decision, new or amended claims are also examined for compliance with 35 USC § § 112 and 132.

P.T.O. Bd.Pat.App. & Int.

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